II. Claim Rej ctions under 35 U.S.C. § 102

A rejection under § 102 is only proper when the claimed subject matter, in this case a method of protecting keratinous fiber from extrinsic damage, is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); *see also* M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly."). Importantly, each and every element of a claim must be set forth in the prior art reference for there to be anticipation. *See* M.P.E.P. § 2131.

A. Ruiseco

Claims 1 and 10 - 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Ruiseco* (U.S. Patent No. 4,849,214) ("*Ruiseco*") for the reasons set forth on pages 3 - 4 of the present Office Action. Applicants respectfully traverse this rejection.

The Examiner asserts that *"Ruiseco* teaches a method of treating dry scalp and skin conditions by placing a composition comprising avocado extracts and arnica." *See* page 3 of the present Office Action. According to the Examiner, "*Ruiseco* teaches that the plant extract composition is effective in treating dry skin conditions which result from treatment of angina, chemotherapy and radiation." *See* pages 3 - 4 of the present Office Action. Further, the Examiner states that "*Ruiseco* teaches methods for the use of his composition for the treatment of hair loss," and "that the amount of avocado is

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400 g of avocado and 500 g [sic] of arnica is used in the making of the referenced composition." *See* page 4 of the present Office Action (citing Claims 3 and 4).

Applicants assert that *Ruiseco* does not identically describe or disclose the method of the present claims for at least the following reasons. The present claims relate to a method of **protecting** keratinous fiber from extrinsic damage comprising applying to said keratinous fiber a composition comprising at least one plant extract chosen from potato extract, mistletoe extract, avocado extract, wheat germ extract, and willowherb extract. In contrast, the method disclosed in *Ruiseco* is directed to "**treatment** of dry skin and scalp conditions." *See* col. 1, line 9 - 11. Specifically, *Ruiseco* claims to restore oil to otherwise dry skin conditions. *See* col. 2, lines 10 -12.

Ruiseco does not discuss protection of keratinous fibers from extrinsic damage. Extrinsic damage is defined in the specification as filed at page 6 as "damage that is caused by conditions such as sun, chemical damage, *e.g.*, from detergents, bleaching, relaxing, dyeing, and permanent waving, and heat, e.g., from hair dryers or curlers." For at least this reason, Applicants submit that *Ruiseco* does not identically describe the invention according to the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

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B. Wolf

Claims 1 and 10 - 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Wolf et al.* (U.S. Patent No. 5,443,855) ("*Wolf*") for the reasons set forth on page 4 of the present Office Action. Applicants respectfully traverse this rejection.

According to the Examiner, "*Wolf* teaches a method of moisturizing and forming a film on skin comprising applying to the skin cosmetic and pharmaceutical compositions comprising kidney bean extract (*Phaesolus vulgaris*) extensin which exert beneficial effects on skin, hair and nails." *See* page 4 of the present Office Action.

As an initial matter, Applicants respectfully note that kidney bean extract (*Phaesolus vulgaris*) is not encompassed within the scope of the present claims.

Further, Applicants assert that *Wolf* does not identically describe or disclose the method of the present claims for at least the following reasons. As previously discussed, the present claims relate to a method of **protecting** keratinous fiber from extrinsic damage comprising applying to said keratinous fiber a composition comprising at least one plant extract chosen from potato extract, mistletoe extract, avocado extract, wheat germ extract, and willowherb extract. In contrast, as noted by the Examiner, the method disclosed in *Wolf* is directed to "**moisturizing and forming a film** on skin." *See* col. 5, lines 45 - 48. Specifically, *Wolf* discloses that compositions "containing effective amounts of extensins improve texture, smoothness, and moisture content of the skin." *See* col. 3, lines 37 - 39.

Accordingly, Applicants submit that *Wolf* does not identically describe or disclose the invention according to the present claims for at least the reason that *Wolf* does not

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disclose a method of protecting keratinous fiber from extrinsic damage. Accordingly, Applicants respectfully request that this rejection be withdrawn.

C. Konishi

Claims 1 and 10 - 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Konishi et al.* (J.P. 62,099,319) ("*Konishi*") for the reasons set forth on page 4 of the present Office Action. Applicants respectfully traverse this rejection.

The Examiner asserts that "*Konishi* teaches a method of protecting hair by applying to the hair and skin an herbal tonic comprising an extract of mistletoe and an extract of *Angelic pubescens* Maxim., in an amount of 0.1 to 5% of the total dried [sic] material in the hair tonic composition." *See* page 4 of the present Office Action. Further, the Examiner states that "*Konishi* teaches that the hair tonic promotes hair growth without skin irritation," and "teaches that the mistletoe has remarkable trichogenous effect." *Id.*

Applicants note that the Examiner has asserted that "*Konishi* teaches a method of protecting hair." *Id.* Applicants, however, are unable to find the disclosure of a "method" of "protecting" anywhere in the English language abstract provided with the present Office Action. Therefore, Applicants respectfully request the Examiner to state for the record where *Konishi* discloses a method of protecting hair.

Assuming *Konishi* does not disclose a "method for protecting" hair, *Konishi* merely provides a composition for promoting hair growth. Hence, *Konishi* does not

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anticipate the presently method of protecting keratinous fiber from extrinsic conditions. Accordingly, Applicants respectfully request that this rejection be withdrawn.

D. Bradbury

Claims 1 - 3, 7 and 9 - 11 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Bradbury et al.* (U.S. Patent No. 4,849,214) ("*Bradbury*") for the reasons set forth on page 5 of the present Office Action. Applicants respectfully traverse this rejection.

The Examiner states that "*Bradbury* teaches a method of topically applying to hair a composition comprising sucrose and willowherb (*Epilobium*)," and that "[t]he method taught by *Bradbury* is used for regulating the growth and loss of hair." *See* page 5 of the present Office Action.

Applicants assert that *Bradbury* does not identically describe or disclose the method of the present claims for at least the following reasons. As repeatedly noted, the present claims relate to a method of **protecting** keratinous fiber from extrinsic damage comprising applying to said keratinous fiber a composition comprising at least one plant extract chosen from potato extract, mistletoe extract, avocado extract, wheat germ extract, and willowherb extract. In contrast, the method disclosed in *Bradbury* is directed to "regulating the growth and loss of hair." *See* col. 27, lines 41- 43.

Accordingly, Applicants assert that *Bradbury* does not anticipate the presently method of protecting keratinous fiber from extrinsic conditions for at least the foregoing reason, and respectfully request that this rejection be withdrawn.

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E. Lupul t

Claims 1, 10 and 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Lupulet et al.* (RO 108529B1) ("*Lupulet*") for the reasons set forth on page 5 of the present Office Action. Applicants respectfully traverse this rejection.

According to the Examiner, "*Lupulet* teaches a method of protecting keratinous tissue by apply [sic] a massage cream to the skin, which promotes penetration of active ingredients and prevents skin damage." *See* page 5 of the present Office Action. Further, the Examiner states that "[t]he massage cream comprises 0.5-3% wheat germ extract and 0.01-2% *Oenothea biennis* (evening primrose oil-a willowherb extract)." *Id.*

Applicants assert that *Lupulet* does not identically describe or disclose the method of the present claims for at least the following reasons. As previously discussed, the present claims relate to a method of protecting keratinous **fiber** from extrinsic damage comprising applying to said keratinous fiber a composition comprising at least one plant extract chosen from potato extract, mistletoe extract, avocado extract, wheat germ extract, and willowherb extract. Claim 11, and page 6 of the specification as filed lists as examples of keratinous fiber hair, eyelashes, and eyebrows. In contrast, as noted by the Examiner, the composition disclosed in *Lupulet* "prevents **skin** damage." *See* page 2 of English-language abstract. *Lupulet* does not mention keratin fiber as defined in the present application.

Accordingly, Applicants assert that, for at least the aforementioned reason, *Lupulet* fails to anticipate the presently method of protecting keratinous fiber from

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extrinsic conditions. Applicants therefore respectfully request that this rejection be withdrawn.

F. Bathhurst

Claims 1 - 6, and 10 - 13 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Bathhurst et al.* (U.S. Patent No. 5,624,672) ("*Bathhurst*") for the reasons set forth on pages 6- 7 of the present Office Action. Applicants respectfully traverse this rejection.

The Examiner asserts that "*Bathhurst* a method of applying to an area of baldness compositions termed phytogenic apoptosis inhibitors (PAIs), which are administered in effective dose amounts to inhibit apoptosis." *See* pages 5 - 6 of the present Office Action. The Examiner acknowledges that PAIs can be isolated from a variety of different plants and plant organs. *See* page 6 of the present Office Action. The Examiner asserts that "*Bathhurst* teaches an anti-apoptotic L/G fraction, wherein the carbohydrate content consists of arabinose and galactose in a 3:2 ratio with fucose, rhamnose, glucosamine, glucose and mannose." *Id.* According to the Examiner, "*Bathhurst* teaches that PAIs can be used to treat various aopotosis-related conditions, including baldness caused by apoptosis of the hair follicles," and that the PAIs "can be used in topical treatment of the skin to prevent continued hair loss for the restoration of normal skin function. *Id.* (citing Claims 1, 6, and 8).

Applicants assert that *Bathhurst* does not identically describe or disclose the method of the present claims for at least the following reasons. As previously

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discussed, the present claims relate to a method of **protecting keratinous fiber from extrinsic damage** comprising applying to said keratinous fiber a composition comprising at least one plant extract chosen from potato extract, mistletoe extract, avocado extract, wheat germ extract, and willowherb extract. As acknowledged by the Examiner, *Bathhurst* is directed to a method of **treatment of apoptosis**. *See e.g.,* Claim 42. "Apoptosis is a normal physiological process that leads to individual cell death." *See* col. 1, lines 16- 17. Thus, *Bathhurst* does not disclose protection of keratinous fiber from extrinsic damage as presently claimed. Accordingly, Applicants assert that, for at least this reason, *Bathhurst* does not anticipate the present claims, and respectfully request withdrawal of this rejection.

G. Carson

Claims 1 - 4, 6 - 7, and 10 - 13 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Carson et al.* (U.S. Patent No. 5,416,075) ("*Carson*") for the reasons set forth on pages 8 - 9 of the present Office Action. Applicants respectfully traverse this rejection.

Applicants assert that *Carson* does not identically describe or disclose the method of the present claims for at least the following reasons. As previously discussed, the present claims relate to a method of **protecting** keratinous fiber from extrinsic damage comprising applying to said keratinous fiber a composition comprising at least one plant extract chosen from potato extract, mistletoe extract, avocado extract, wheat germ extract, and willowherb extract. In contrast, as noted by the Examiner, the

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method disclosed in *Carson* is directed to "**deliv ring** a lipophilic material to a microorganism or to a biological surface" or to "**delivering** an amphipathic compound" to the same. *See e.g.,* Claims 17 and 18. *Carson* does not teach or suggest a method for protecting keratinous tissue. Further, *Carson* does not disclose at least one plant extract chosen from potato extract, mistletoe extract, avocado extract, wheat germ extract, and willowherb extract. *See e.g.,* col. 11, lines 59 - 60.

Accordingly, Applicants submit that *Carson* does not identically describe or disclose the invention according to the present claims for at least the reason that *Carson* does not disclose a method of protecting keratinous fiber from extrinsic damage. Accordingly, Applicants respectfully request that this rejection be withdrawn.

H. Tolpa

Claims 1 - 3 and 10 - 13 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Tolpa et al.* (U.S. Patent No. 5,747,050) ("*Tolpa*") for the reasons set forth on pages 9 - 10 of the present Office Action. Applicants respectfully traverse this rejection.

The Examiner asserts that "*Tolpa* teaches a method of administering a composition comprising a peat-derived bioactive product and herb extract in the form of either a gel or an ointment." *See* page 9 of the present Office Action. Further, the Examiner asserts that "the peat-derived product primarily contains polysaccharides, and other mineral and organic compounds which have nourishing and stimulating effects on humans and mammals." *Id.* According to the Examiner, "*Tolpa* teaches that the use of

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a hair balm comprising peat-derived produce [sic]...prevents excessive drying of the hair and skin" (citing col. 11, lines 9-40).

Applicants assert that *Tolpa* does not identically describe or disclose the method of the present claims for at least the following reason. As previously discussed, the present claims relate to a method of **protecting** keratinous fiber from extrinsic damage comprising applying to said keratinous fiber a composition comprising at least one plant extract chosen from potato extract, mistletoe extract, avocado extract, wheat germ extract, and willowherb extract. In contrast to the Examiner's assertions, *Tolpa* does not teach that "the use of a hair balm comprising peat-derived produce [sic]...prevents excessive drying of the hair and skin" (citing col. 11, lines 9-40). Instead, *Tolpa* relates to "novel peat-derived bioactive products and to a process for producing such products" (*see* col. 1, lines 8 - 9), and provides a process for obtaining a peat-derived product (*see e.g.,* Claim 5). The disclosure cited by the Examiner, specifically col. 11, lines 9 - 40, discloses a recipe for a hair balm which may contain "components preventing excessive drying of hair." *See* col. 11, line 11. *Tolpa* does not disclose protection of keratinous fiber from extrinsic damage as presently claimed. Accordingly, Applicants assert that, for at least this reason, *Tolpa* does not anticipate the present claims, and respectfully request withdrawal of this rejection.

III. Claim Rejections under 35 U.S.C. § 103

Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Carson* or *Tolpa,* in view of *Ruiseco*, and further in view of *Konishi* for the reasons

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set forth on pages 10 - 11 of the present Office Action. Applicants respectfully traverse this rejection.

The Examiner acknowledges that "[n]either *Carson* nor *Tolpa* teach a method of protecting keratinous fiber from extrinsic damage comprising applying to the keratinous fiber a composition comprising mistletoe extract or avocado extract." *See* page 10 of the present Office Action. The Examiner then asserts that "it would have been obvious to one of skill in the art at the time the invention was made to modify the methods taught by either *Carson* or *Tolpa* to provide a method of protecting keratinous fiber from extrinsic damage by replacing the referenced plant extracts taught by *Carson* and *Tolpa* with either avocado extract or mistletoe extract because *Ruiseco* teaches that the application of avocado extract is effective in the treatment of hair loss and dry skin conditions due to the use of heart medication, and exposure to chemotherapy and radiation, and *Konishi* teaches a mistletoe extract containing hair formulation with trichogenous effect which promotes hair growth without skin irritation." *See* pages 10 - 11 of the present Office Action. Further, the Examiner asserts that "[o]ne of skill in the art at the time the invention was made would have been motivated and one would have had a reasonable expectation of success that the substitution of one plant extract for the other would provide the claimed method because both *Ruiseco* and *Konishi* teach the beneficial effects of incorporating extracts of avocado and mistletoe in compositions used in methods for the protection of keratinous fiber from extrinsic damage and *Tolpa* expressly teaches that herb extracts synergistically improve the therapeutic effect of his

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compositions when used in methods for the treatment of certain diseases." *See* page 11 of the present Office Action.

To establish a *prima facie* case of obviousness, an Examiner must meet three basic criteria. First, he or she must demonstrate that there is some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine reference teachings. Second, an Examiner must demonstrate that there was a reasonable expectation of success. Finally, the prior art reference(s) must also teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Furthermore, the teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicants' disclosure. *See* In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In the present case, the Examiner has failed to make a *prima facie* case of obviousness because none of the above criteria have been met.

First and foremost, even if, *arguendo*, *Carson* or *Tolpa* were modified by *Ruiseco* and *Konishi* in the manner suggested by the Examiner, Applicants assert that the resultant modification would not render the present claims obvious because that combination would not teach or suggest all of the limitations of the present claims. As discussed with respect to the rejections under 35 U.S.C. § 102 above, not one of *Carson, Tolpa, Ruiseco* and *Konishi* disclose a method of protecting keratinous from extrinsic damage. Consequently, the modification of *Carson* or *Tolpa* by *Ruiseco* and *Konishi* to replace the referenced plant extracts would not teach or suggest such a

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method. Therefore, for at least this reason, Applicants submit that the Examiner has failed to make a *prima facie* case of obviousness.

Addditionally, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See* M.P.E.P. § 2143.01 (emphasis in original). Applicants respectfully disagree with the Examiner's statement that "*Ruiseco* teaches that the application of avocado extract is effective in the treatment of hair loss and dry skin conditions." *See* page 10 of the present Office Action. In contrast, Applicants assert that *Ruiseco* never attributes any benefits from the patented composition to avocado extract alone, instead referring to the composition as a whole. *See e.g.,* col. 4, line 20 ("The benefits from this composition"). Thus, Applicants assert that one of skill in the art would not have had the requisite motivation to separate the avocado seed extract of *Ruiseco* from the other components in those compositions in order to replace the referenced plant extracts in other known compositions as suggested by the Examiner.

Similarly, there would have been no motivation to combine *Carson* or *Tolpa* and *Konishi*. The Examiner asserts that the motivation comes from the fact that "*Konishi* teach[es] the beneficial effects of incorporating extracts of...mistletoe." The "beneficial effects of incorporating extracts of mistletoe" disclosed in *Konishi* include a "very remarkable trichogenous and hair growth promoting effect." Applicants assert that neither *Carson* nor *Tolpa* disclose the desirability of such a beneficial effect. In fact neither of the aforementioned references mentions hair loss, hair growth or anything

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similar. Therefore, Applicants assert that one of skill in the art would not have had the requisite motivation to combine these references and *Konishi*'s extract in order to take advantage of the 'remarkable trichogenous effect' disclosed therein.

Therefore, neither *Ruiseco*, *Konishi, Carson*, nor *Tolpa* provide the requisite motivation to modify in the manner suggested by the Examiner. Accordingly, for at least the foregoing reasons, the modification of *Carson* or *Tolpa* by *Ruiseco* and *Konishi* fails to render the present claims obvious, and Applicants respectfully request the withdrawal of this § 103(a) rejection.

IV. Provisional Double Patenting Rejection

Claims 1 - 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 13 of copending Application No. 09/527,599 for the reasons set forth on pages 11 -12 of the present Office Action. Applicants respectfully traverse this rejection, but, at this time, respectfully request that this rejection be held in abeyance until allowable subject matter is indicated. At that time, Applicants will consider whether or not to file a Terminal Disclaimer.

V. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: Reg No. 41,469 for
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